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EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,400

Applicant(s)

SUSSMAN, LESTER

Examiner

Luke Gilligan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claims 1-15 have been examined.

Claim Objections

1. Claim 7 is objected to because of the following informalities: Claim 7 appears to be inadvertently dependent on claim 7 rather than claim 6. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 3, and 6-15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 2 recites "said input means to input data is a computer, a personal digital assistant, a wireless telephone with input means and an Internet Appliance." However, claim 1, from which claim 2 depends, only recites a single input means rather than a plurality of input means. Therefore, it is unclear how a plurality of different input means can make up the single recited input means. For examination purposes, the Examiner will interpret the limitation of claim 2 to recite said input means as one of the those listed.
5. Claim 3 recites the limitation "said means of communication is the Internet Protocol." Since there is more than one type of Internet protocol, such as HTTP and FTP, it is unclear what particular protocol this is referring to.
6. Claim 6 recites the limitation "said scheduled of appointments" at step (f). The claim does not previously recite a plurality of appointments, scheduled or otherwise. For examination purposes, the Examiner will interpret this limitation as "said scheduled appointment."

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7. Claims 7-8 contain the same deficiencies as claim 6 through dependency and, as such, are rejected for the same reasons.

8. Claim 9 recites the limitation "said predetermined prescription drugs requiring utilization review" at step (e). There is no previous recitation of prescription drugs requiring utilization review. Therefore, there is insufficient antecedent basis for this limitation in the claim.

9. Claims 11-15 contain the same deficiencies as claim 9 through dependency and, as such, are rejected for the same reasons.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Liff et al., U.S. Patent No. 6,283,322.

12. As per claim 1, Liff teaches a medical drug prescription health care management system comprising: (a) input means for entering data identifying each of a predetermined plurality of persons (see column 17, lines 60-64); (b) a data memory interconnected with said input means, said data memory including an identification of predetermined medical prescription drugs requiring utilization review (see column 18, line 64 – column 19, line 11); (c) payment means (see column 16, lines 55-59); (d) means in communication with said input means responsive to input of data through said input means symbolic of prescription drugs of one of said

predetermined plurality of persons of a proposed mode of treatment for said one of said predetermined plurality of persons (see column 19, lines 35-49) and, when said proposed mode of treatment includes one of said predetermined prescription drugs requiring utilization review, for producing indicia thereof and for preventing selection therefore until said utilization review has been obtained and data indicative thereof has been entered in said system (see column 20, lines 1-5); and (e) said predetermined plurality of persons are patients of medical doctors (see column 2, lines 8-14).

13. As per claim 2, Liff teaches the system of claim 1 as described above. Liff further teaches said input means to input data is a computer (see column 5, lines 59-63).

14. As per claim 3, Liff teaches the system of claim 1 as described above. Liff further teaches said means of communication is an Internet protocol (see column 23, lines 16-23).

15. As per claim 5, Liff teaches the system of claim 1 as described above. Liff further teaches said prescription drug utilization review is determined by said patient's health insurance provider (see column 19, lines 22-49).

16. Claims 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Ilse et al., U.S. Patent No. 6,757,898.

17. As per claim 6, Ilse teaches a medical drug prescription health care management system comprising: (a) input means for entering data identifying each of a predetermined plurality of persons (see column 4, lines 57-63); (b) a data memory interconnected with said input means, said data memory including an identification of said plurality of persons requiring medical attention by a medical doctor (see column 5, lines 28-30); (c) said predetermined plurality of persons are patients of medical doctors (see column 5, lines 28-30); (d) payment means (See column 11, lines 17-22); (e) input means for scheduling an appointment between

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said patient and said medical doctor such that said patient need not directly interact with staff at said doctor's medical office (see column 5, lines 36-43); (f) means to store said scheduled appointment in a data memory (see column 5, lines 31-35); (g) means to notify said patient of said scheduled appointment with said doctor and any changes thereof (see column 13, lines 55-62).

18. As per claim 7, Ilsen teaches the system of claim 6 as described above. Ilsen further teaches said input means for scheduling an appointment is the World Wide Web (see column 6, lines 21-27).

19. As per claim 8, Ilsen teaches the system of claim 7 as described above. Ilsen further teaches said means of notification is sending an electronic-mail message, or a simple-mail message to a wireless telephone, or a pager message, or a voice-mail message to a telephone mailbox, or a manual interaction with said patient (see column 11, lines 15-38).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liff et al., U.S. Patent No. 6,283,322 in view of Wallace et al., U.S. Patent No. 6,564,121.

22. As per claim 4, Liff teaches the system of claim 1 as described above. Liff does not explicitly teach said payment means is credit card payment means. Wallace teaches a healthcare management system that includes payment means in the form of credit card payment means (see column 3, lines 11-17). It would have been obvious to one of ordinary skill

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in the art at the time of the invention to incorporate such payment means into the system of Liff. One of ordinary skill in the art would have been motivated to incorporate such means for the purpose of accommodating user preferences as to payment means for payments not covered by insurance payors such as co-payments as is standard and well known in the prescription drug environment.

23. Claims 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ilse, U.S. Patent No. 6,757,898 in view of Liff et al., U.S. Patent No. 6,283,322.

24. As per claim 9, Ilse teaches a medical drug prescription health care management system comprising: (a) input means for entering data identifying each of a predetermined plurality of persons (see column 4, lines 57-63); (b) a data memory interconnected with said input means, said data memory including an identification of said plurality of persons requiring medical attention by a medical doctor (see column 5, lines 28-30); (c) said predetermined plurality of persons are patients of medical doctors (see column 5, lines 28-30); (d) payment means (See column 11, lines 17-22); (e) means in communication with said input means responsive to input of data through said input means symbolic of prescription drugs of one of said predetermined plurality of persons for a proposed mode of treatment for said one of said predetermined plurality of persons (see column 19, lines 41-45); (f) means to communicate said selected prescription drug, or plurality thereof to a pharmacy to fill prescription orders for said patient (see column 19, lines 41-45); (g) means to notify said patient of said prescription's fill status with said pharmacy and any changes thereof (see column 19, lines 51-57); (h) means to obtain said pharmacy filled prescription by said patient (see column 30, lines 63-64); (i) means to refill said medical drug prescription (see column 19, lines 44-45).

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25. Ilsen does not explicitly teach producing indicia indicative of prescription drugs requiring utilization review. Liff teaches producing indicia indicative of prescription drugs requiring utilization review (see column 19, lines 35-49). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this drug utilization review feature into the system of Ilsen. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of enhancing the drug prescribing and dispensing features of Ilsen in a safe and cost effective manner (see column 2, lines 5-14).

26. As per claim 10, Ilsen in view of Liff teach the system of claim 9 as described above. Ilsen further teaches said means to communicate said selected prescription drug to a pharmacy is by means of the World Wide Web (see column 6, lines 21-27).

27. As per claim 11, Ilsen in view of Liff teach the system of claim 9 as described above. Ilsen further teaches said means to communicate said selected prescription drug to a pharmacy is by means of direct interaction with the pharmacy's order entry database system (see column 19, lines 45-51).

28. As per claim 12, Ilsen in view of Liff teach the system of claim 9 as described above. Ilsen further teaches said means of notification is sending an electronic-mail message, or a simple-mail message to a wireless telephone, or a pager message, or a voice-mail message to a telephone mailbox, or a manual interaction with said patient (see column 11, lines 15-38).

29. As per claim 13, Ilsen in view of Liff teach the system of claim 9 as described above. Ilsen further teaches said means to obtain pharmacy filled prescription by said patient is delivery means, or pick-up from the pharmacy counter, or pick-up from the pharmacy drive-through means (see column 19, lines 51-56).

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30. As per claim 14, Ilсен in view of Liff teach the system of claim 9 as described above. Ilсен further teaches said refill means is by means of a database automatic timed reminder means when said prescription is about to become depleted (see column 20, lines 52-67).

31. As per claim 15, Ilсен in view of Liff teach the system of claim 9 as described above. Ilсен further teaches said refill means is by means of said patient placing a refill order for said prescription drugs by means of the Internet (see column 6, lines 21-27 and column 19, lines 41-45).

Conclusion

32. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

33. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

34. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'C. Luke Gilligan', with a long horizontal flourish extending to the right.

C. Luke Gilligan
Patent Examiner
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